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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/470,424	06/06/1995	OSAMU YOKOMIZO		7423

20457 7590 03/22/2005

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EXAMINER

BEHREND, HARVEY E

ART UNIT	PAPER NUMBER
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3641

DATE MAILED: 03/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Communication Re: Appeal**

Application No.

08/470,424

Applicant(s)

YOKOMIZO ET AL.

Examiner

Harvey E. Behrend

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

1. ☐ The Notice of Appeal filed on \_\_\_\_\_ is not acceptable because:

- (a) ☐ it was not timely filed.
- (b) ☐ the statutory fee for filing the appeal was not submitted. See 37 CFR 1.17(b).
- (c) ☐ the appeal fee received on \_\_\_\_\_ was not timely filed.
- (d) ☐ the submitted fee of \$\_\_\_\_\_ is insufficient. The appeal fee required by 37 CFR 1.17(b) is \$\_\_\_\_\_.
- (e) ☐ the appeal is not in compliance with 37 CFR 1.191 in that there is no record of a second or a final rejection in this application.
- (f) ☐ a Notice of Allowability, PTO-37, was mailed by the Office on \_\_\_\_\_.

2. ☐ The appeal brief filed on \_\_\_\_\_ is NOT acceptable for the reason(s) indicated below:

- (a) ☐ the brief and/or brief fee is untimely. See 37 CFR 1.192.
- (b) ☐ the statutory fee for filing the brief has not been submitted. See 37 CFR 1.17(c).
- (c) ☐ the submitted brief fee of \$\_\_\_\_\_ is insufficient. The brief fee required by 37 CFR 1.17(c) is \$\_\_\_\_\_.

**The appeal in this application will be dismissed unless corrective action is taken to timely submit the brief and requisite fee. Extensions of time may be obtained under 37 CFR 1.136(a).**

3. ☒ The appeal in this application is DISMISSED because:

- (a) ☐ the statutory fee for filing the brief as required under 37 CFR 1.17(c) was not timely submitted and the period for obtaining an extension of time to file the brief under 37 CFR 1.136 has expired.
- (b) ☒ the brief was not timely filed and the period for obtaining an extension of time to file the brief under 37 CFR 1.136 has expired. *See attachment.*
- (c) ☐ Request for Continued Examination (RCE) under 37 CFR 1.114 was filed on \_\_\_\_\_.
- (d) ☐ other: \_\_\_\_\_

4. ☒ Because of the dismissal of the appeal, this application:

- (a) ☒ is abandoned because there are no allowed claims.
- (b) ☐ is before the examiner for final disposition because it contains allowed claims. Prosecution on the merits remains CLOSED.
- (c) ☐ is before the examiner for consideration of the submission and prosecution has been reopened pursuant to 37 CFR 1.114.

The appeal brief filed 2/23/04 still does not comply with the requirements of 37 CFR 1.192(c) and, the period to file a corrected Appeal brief has expired.

As set forth in MPEP 1206, the question of whether a brief complies with 37 CFR 1.192(c) is a matter within the jurisdiction of the examiner.

The appeal is accordingly dismissed in accordance with the requirements of 37 CFR 1.92(d) which states that if appellant files an amended brief which does not overcome all of the reasons for non-compliance stated in the notice of non-compliance, the appeal will stand dismissed.

The first brief filed 10/26/01 was held defective for several reasons in the 6/20/03 Office action.

The second brief filed 7/21/03 failed to correct three of those reasons.

The third brief filed 2/23/04 failed to correct two of these reasons.

The first of these reasons concerns the Summary of the Invention.

The Summary of the invention as presented in the 2/23/04 brief in attempting to describe appellants invention, still improperly incorporates subject matter from US 4,285,769 (e.g. see pages 9 and 10 of the brief). Such is improper since this U.S. Patent has not been incorporated by reference into appellants specification.

Appellant in his arguments specifically states he is relying on the subject matter disclosed in US 4285769 as evidence of the knowledge of those skilled in the art and, as providing a meaning for the term "one fuel cycle" (which term is present in appellant's claims).

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It is considered clear on its face that evidence (which is not a part of appellant's disclosure and which is being relied on by appellant to attempt to overcome rejections), is not a proper part of the Summary of appellants claimed invention.

As previously pointed out, appellant can include this subject matter as part of the Arguments section of the brief or, it could be presented under a separate heading if it is made clear that it is subject matter that may not be supported by the original disclosure but merely provided to enhance the understanding of technical aspects in the art.

The second of these two reasons is that the brief includes the statement required by 37 CFR 1.192(c)(7) that one or more claims do not stand or fall together, yet does not present arguments in support thereof in the arguments section of the brief. The 2/23/04 brief still does not comply with this requirement because (as set forth in MPEP 1206 part (7)), merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

37 CFR 1.192(c)(7) requires appellant to perform two affirmative acts in the brief to have the separate patentability of a plurality of claims subject to the same rejection considered.

See MPEP 1206 which states:

"It should be noted that 37 CFR 1.192(c)(7) requires the appellant to perform two affirmative acts in his or her brief in order to have the separate patentability of a plurality of claims subject to the same rejection considered. The appellant must (A) state that the claims do not stand or fall together and (B) present arguments why the claims subject to the same rejection are separately patentable. Where the appellant does neither, the claims will be treated as standing or falling together. Where, however, the appellant (A) omits the statement required by 37 CFR 1.192(c)(7) yet presents arguments in the argument section of the brief, or (B) includes the statement required by 37 CFR 1.192(c)(7) to the effect that one or more claims do not stand or fall together (i.e., that they are separately

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patentable) yet does not offer argument in support thereof in the "Argument" section of the brief, the appellant should be notified of the noncompliance as per 37 CFR 1.192(d). *Ex parte Schier*, 21 USPQ2d 1016 (Bd. Pat. App. & Int. 1991) ; *Ex parte Ohsumi*, 21 USPQ2d 1020 (Bd. Pat. App. & Int. 1991). "

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harvey Behrend whose telephone number is (703) 305-1831. The examiner can normally be reached on Tuesday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone, can be reached on (703) 306-4198. The fax phone number for the organization where this application or proceeding is assigned is (703) 306-4195.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-1113.



Behrend/vs  
October 15, 2004

HARVEY E. BEHREND  
PRIMARY EXAMINER